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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GLEN FRIEDMAN and DAN KIKINIS

Appeal 2009-009963
Application 09/997,713
Technology Center 2100

Before JOHN A. JEFFERY, ST. JOHN COURTENAY III, and THU A. DANG, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-7, 18, and 20. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Appellants' invention enables viewing desired portions of a multimedia presentation via an annotation file with pointers to the desired

portions. *See generally* Abstract; Spec. ¶ 0006. Claim 1 is illustrative with key disputed limitations emphasized:

> 1. A method comprising:
>
> automatically identifying a plurality of desired portions of a multimedia presentation by user's equipment;
>
> automatically creating, at the user's equipment, an annotation file for the multimedia presentation, the annotation file containing a first pointer corresponding to a first desired portion of the plurality of desired. portions and. a second pointer corresponding to a second desired portion of the plurality of desired portions, wherein the first desired portion and the second desired portion is separated in the multimedia presentation by an intervening portion; and
>
> using the plurality of pointers to automatically present only the plurality of desired portions of the multimedia presentation without presenting any other portion of the multimedia presentation including the intervening portion, wherein *the second desired portion is displayed automatically after the first desired portion without user interaction.*

The Examiner relies on the following as evidence of unpatentability:

Bennett	US 5,884,256	Mar. 16, 1999
Kelly	US 5,907,322	May 25, 1999
Boreczky	US 6,366,296 B1	Apr. 2, 2002 (filed Sept. 11, 1998)
Gupta	US 6,546,405 B2	Apr. 8, 2003 (filed Oct. 23, 1997)

THE REJECTIONS

1. The Examiner rejected claims 1-5 and 13-17 under 35 U.S.C. § 103(a) as unpatentable over Gupta, Boreczky, and Bennett. Ans. 3-8.[1]
2. The Examiner rejected claims 6, 7, 18, and 20 under 35 U.S.C. § 103(a) as unpatentable over Gupta, Boreczky, Bennett, and Kelly. Ans. 8-9.

THE OBVIOUSNESS REJECTION OVER GUPTA, BORECZKY, AND BENNETT

Regarding representative claim 1, the Examiner finds that Gupta discloses a method for creating an annotation file for a multimedia presentation with pointers corresponding to desired portions of the presentation with every recited feature except for (1) automatically identifying the desired portions via user equipment, and (2) displaying the second desired portion automatically after the first desired portion without user interaction as claimed. Ans. 3-7, 11-13. The Examiner, however, cites Boreczky and Bennett to cure these respective deficiencies in concluding the claim would have been obvious. *Id.*

Appellants argue the cited prior art fails to teach or suggest displaying automatically a second desired portion of the presentation after the first desired portion *without user interaction* since Bennett's system requires manual interaction to move between marked portions of the recorded material. App. Br. 4-5; Reply Br. 1-2 (emphasis in original).

[1] Throughout this opinion, we refer to (1) the Appeal Brief filed October 28, 2008; (2) the Examiner's Answer mailed December 23, 2008; and (3) the Reply Brief filed February 23, 2009.

The issue before us, then, is as follows:

ISSUE

Under § 103, has the Examiner erred in rejecting claim 1 by finding that Gupta, Boreczky, and Bennett collectively would have taught or suggested automatically displaying a second desired portion of a multimedia presentation after a first desired portion without user interaction, where the first and second desired portions are separated by an intervening portion that is not presented?

FINDINGS OF FACT (FF)

1. The Examiner's factual findings regarding the disclosures of Gupta and Boreczky (Ans. 3-6, 11-12) are undisputed.

2. Bennett's networked stenographic transcription system (1) converts speech to text in real time via a recorder 11 and court reporter's terminal 13, and (2) communicates this text to attorney terminals 15-18 for real-time viewing during legal proceedings. Bennett, Abstract; col. 1, ll. 23-28; col. 8, l. 45 – col. 9, l. 10; Fig. 1.

3. An attorney terminal in Bennett has a user interface enabling the user to select portions of the communicated text and associate supplemental information with the text. During review, the user can then sequentially review selected textual portions by skipping unselected portions of the text. Bennett, Abstract.

4. An examining attorney's terminal 15 includes a screen with (1) a communication window 257, and (2) a transcription window 255 that displays the transcribed text such that a particular question ("Q") and answer

("A") are simultaneously displayed along with the corresponding number (e.g., "57"). Bennett, col. 17, l. 15 – col. 18, l. 9; Figs. 6a-6b. An examining attorney's terminal is shown in Bennett's Figure 6b reproduced below:

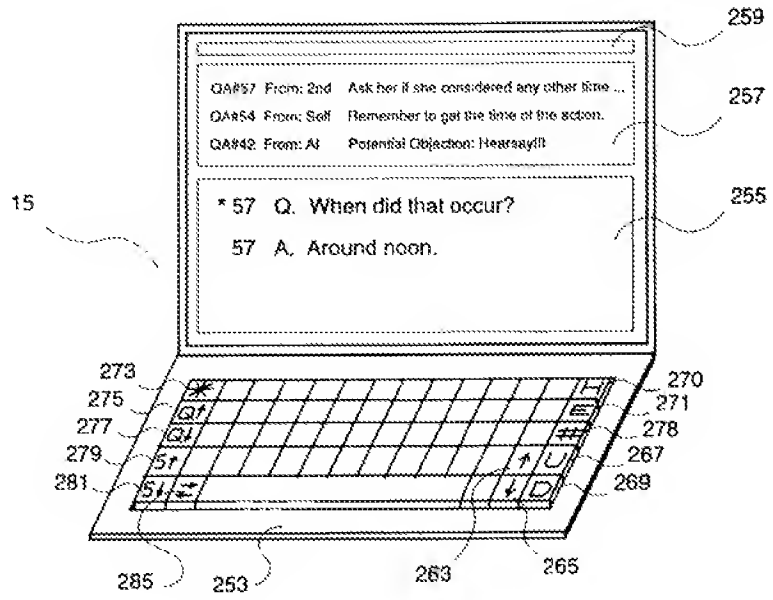

FIG. 6b

An examining attorney's terminal in Bennett's Figure 6b

5. Terminal 15's keyboard 253 includes (1) a "mark" key 273 that marks any Q & A for future reference with an asterisk, and (2) "quick-up" and "quick down" keys 275, 277 that permit scrolling only through the asterisked marked questions. The attorney can thus refer back to previously-marked Q & A's via successive strokes to the quick-up key 275 to page backward through previously-marked Q & A's. The stroking end key 271 returns the display in window 255 to the pending question. Bennett, col. 18, ll. 25-51; Fig. 6b.

ANALYSIS

Based on the record before us, we find no error in the Examiner's obviousness rejection of representative claim 1 which calls for, in pertinent part, *automatically* displaying a second desired portion of a multimedia presentation after a first non-contiguous desired portion *without user interaction*. We emphasize the terms "automatically" and "without user interaction" here, for this dispute turns on whether it would have been obvious to automatically successively display desired non-contiguous portions of a multimedia presentation in lieu of manually displaying those portions in light of the teachings of the cited prior art.

We note at the outset that the Examiner's findings regarding the disclosures of Gupta and Boreczky are undisputed. FF 1. Nor do Appellants dispute the combinability of the respective teachings of Gupta, Boreczky, and Bennett. *See* App. Br. 4-5; Reply Br. 1-2. Rather, Appellants dispute the Examiner's reliance on Bennett for teaching automatically displaying the second desired portion of a multimedia presentation after the first desired portion without user interaction as claimed, since Bennett is said to require manual interaction to move between marked portions of the recorded material. *Id.*

Bennett's system enables users to scroll through previously-marked portions of a transcript of a legal proceeding (i.e., display particular desired (marked) questions and answers) via the "quick-up" or "quick-down" keys. FF 5. Users can also return the display to the currently-pending question from another question via a different key. *Id.* Although *initially triggering* this functionality requires user interaction (i.e., selecting the appropriate key), once the function is triggered, *successively displaying* particular

marked questions and answers on the terminal screen is automatic. *See* FF 4-5. That is, the terminal's functionality that scrolls and displays only previously-marked questions and answers is automatic in that no user intervention is required once the key is pressed. *See id.* In short, the user simply has no role in *the terminal's* automatically converting the display from the visual representation of one question/answer pair to another (which may be non-contiguous question/answer pairs depending on marking) responsive to the initial trigger. *See* FF 3-5. For this reason alone, we are unpersuaded of error in the Examiner's reliance on Bennett in curing the deficiencies of Gupta and Boreczky for at least suggesting automatically displaying the second desired portion of a multimedia presentation after the first desired portion without user interaction as claimed.

And even if we were to assume for the sake of argument that Bennett's scrolling and successively displaying previously-marked question/answer pairs was entirely manual (which it is not for the reasons noted above), it is well settled that where, as here, merely providing a mechanical or automatic means to replace manual activity to accomplish the same result (i.e., successively displaying desired non-contiguous portions of a presentation) is an obvious improvement. *See In re Venner*, 262 F.2d 91, 95 (CCPA 1958). Nor have Appellants shown that automatically displaying these respective desired portions in lieu of manual interaction would have been uniquely challenging or otherwise beyond the level of ordinarily skilled artisans. *See Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

We are therefore not persuaded that the Examiner erred in rejecting representative claim 1, and claims 2-5 not separately argued.

THE OBVIOUSNESS REJECTION OVER GUPTA, BORECZKY, BENNETT, AND KELLY

Regarding representative claim 6, the Examiner finds that Gupta, Boreczky, and Bennett collectively teach or suggest every recited feature except for (1) broadcasting an event to a first location, and (2) simultaneously identifying a desired portion of the event at a remote location, but cites Kelly to cure these deficiencies in concluding that the claim would have been obvious. Ans. 8-9, 13-14. In reaching this conclusion, the Examiner relies on the functionality associated with broadcast events in connection with Kelly's activity log. Ans. 13-14.

Appellants argue that the cited prior art does not teach or suggest transmitting the annotation file *from* a location remote from the first location to which an event is broadcast to a viewing system as a transmission distinct from the broadcast as claimed. App. Br. 6; Reply Br. 3 (emphasis in original). According to Appellants, Kelly transmits an activity table *to* a remote online database—not *from* that remote location as the claim requires. *Id.* The issue before us, then, is as follows:

ISSUE

Under § 103, has the Examiner erred in rejecting claim 6 by finding that Gupta, Boreczky, Bennett, and Kelly collectively would have taught or suggested transmitting an annotation file from a location remote from the

first location to which an event is broadcast to a viewing system as a transmission distinct from the broadcast?

ADDITIONAL FINDINGS OF FACT

6. Kelly's system (1) bookmarks viewer-selected TV broadcast events, and (2) displays associated internet locations or website hotlinks. To this end, (1) a set of broadcast events is selected using a remote control; (2) associated event-identifier data are stored in an "activity table"; and (3) associated internet locations or hotlinks are generated such that the viewer can access and display internet locations associated with the selected broadcast events. Kelly, Abstract.

7. When the viewer activates select button 15 on the remote control 12 to bookmark a broadcast event, an activity record (AR) entry comprising data describing the date, time, and channel is stored into electronic memory 202. The stored AR entries collectively constitute an activity table (AT) 204. Kelly, col. 2, ll. 37-65; Fig. 1.

8. When the user is ready to browse the websites associated with the selected broadcast events, the AT comprising the AR entries and viewer identifying data is sent to central database 40. The AT is then used to determine which data in the database should be retrieved and presented to the user. Database 40 then generates a custom list of data for the user which includes bookmarks associated with the broadcast event (e.g., a web page on the internet) which the viewer can then view with a browser. Kelly, col. 3, ll. 4-28; Fig. 1.

ANALYSIS

Based on the record before us, we find no error in the Examiner's obviousness rejection of representative claim 6 which recites, in pertinent part, transmitting an annotation file *from* a location remote from the first location to which an event is broadcast to a viewing system as a transmission distinct from the broadcast.

First, our previous discussion regarding claim 1 applies equally here, and we are unpersuaded of Appellants' commensurate arguments in this regard for the reasons previously discussed.

Second, although Kelly's system transmits the activity table to an online database as Appellants argue (FF 8; App. Br. 6; Reply Br. 3), data based on this activity table—including the broadcast's bookmarks—are nonetheless sent to the viewer *from* this remote database to facilitate retrieval of content related to the broadcast, yet via a transmission distinct from the broadcast. *See* FF 6-8. Based on this functionality, we see no reason why this transmission of pointer-based content to the viewer as an adjunct to the broadcast would not at least suggest transmitting an annotation file to a viewing system distinct from the broadcast transmission as claimed.

We are therefore not persuaded that the Examiner erred in rejecting representative claim 6, and claims 7, 18, and 20 not separately argued with particularity.

CONCLUSION

The Examiner did not err in rejecting claims 1-7, 18, and 20 under § 103.

ORDER

The Examiner's decision rejecting claims 1-7, 18, and 20 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

pgc